

### **Remarks**

Claim 34 is pending the application. Claims 37-39 have been cancelled without prejudice. Claim 34 has been amended. Support for the claim amendment can be found throughout the application, including the originally-filed claims. Importantly, no new matter has been added to the claims.

Moreover, the claim amendment and claim cancellation should in no way be construed to be an acquiescence to any of the rejections. Rather, the amendments to the claims and claim cancellation are being made solely to expedite the prosecution of the above-identified application. Consequently, Applicants expressly reserve the option to further prosecute the same or similar claims in the instant or subsequent patent application. 35 U.S.C. §§ 120-121.

### **Election of Species**

Applicants have amended claim 1 to include F, Cl, and Br as possible definitions for X. Support for this amendment can be found in claim 1 as originally filed. These species were canceled in Applicants response dated July 3, 2001, as being drawn to a non-elected species. Applicants respectfully request that these species be examined following resolution of the species where X = OH in accordance with MPEP § 803.02. Because examination of the species where X = OH is still ongoing, Applicants submit that examination up until this point will not be affected by reintroduction of these species and request that their reintroduction be allowed.

### **Response to Rejections under 35 U.S.C. § 102(b)**

Claims 34, 37, and 38 stand rejected under 35 U.S.C. § 102(b) based on the Examiner's contention that they are anticipated by U.S. Patent No. 4,820,525 to Leonard et al. (the "'525 patent"). Applicants respectfully traverse this rejection.

Claim 34 has been amended to include the elements of claim 39 which the Examiner did not reject over the '525 patent. Claims 37-39 have been canceled accordingly to avoid redundancy and improper dependency.

Applicants submit that claim 34 is not anticipated by the '525 patent and request the withdrawal of the 35 U.S.C. § 102(b) rejection of claim 34 over the '525 patent.

**Response to Rejections under 35 U.S.C. § 112¶2**

Claims 34, and 37-39 stand rejected under 35 U.S.C. § 112¶2 based on the Examiner's contention that they are indefinite for failing to particularly point out an distinctly claim the subject matter which the Applicants regard as the invention. In particular, the Examiner contends that the terms "vinyl," "acrylic," "acrylate," "elastomeric," and "resin" are vague. Applicants respectfully traverse this rejection.

"A fundamental principle contained in 35 U.S.C. 112¶2 is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art." (MPEP § 2173.01 at 2100-194).

"Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." (MPEP § 2173.02 at 2100-194).

Regarding claims 37-39, Applicants submit that the rejection has been rendered moot by the cancellation these claims. Regarding claim 34, Applicants submit that one of ordinary skill in the art would recognize a vinyl, acrylic or acrylate coating as a polymeric coating. Applicants also submit that one of ordinary skill in the art would recognize that elastomers is an abbreviation for elastomeric polymers. However, solely to expedite prosecution to allowance, Applicants have amended claim 34 to included the term "polymer" following vinyl, acrylic, acrylate, and elastomeric.

"The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, *not in a vacuum*, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." (MPEP § 2173.02 at 2100-194) (emphasis added).

"In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine *whether the claim apprises one of*

*ordinary skill in the art* of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph.” (MPEP § 2173.02 at 2100-194) (emphasis added).

“Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, *in light of the specification*.” (MPEP § 2173.05(b) at 2100-196) (emphasis added); *see also Ex parte Porter, Jr.*, 1992 Pat. App. LEXIS 27 (in reversing the decision of the examiner, the Board of Patent Appeals stated, “the scope of claim 7 would be reasonably ascertainable by those skilled in the art”); *Ex parte Adrianus*, 1987 Pat. App. LEXIS 27 (examiner reversed); *Ex parte George et al.*, 1984 Pat. App. LEXIS 3 (examiner reversed); *Ex parte Spenny*, 1983 Pat. App. LEXIS 24 (“*the terms objected to when read in the light of the specification would not be indefinite. A worker in the art would recognize what is intended to be included and excluded by the objected to terms....*Therefore, the claim are considered to be in compliance with the second paragraph of 35 U.S.C. 112.”) (emphasis added).

Here, Applicants also submit that one of ordinary skill in the art would recognize the class of coatings referred to as “resin.” To support this contention, Applicants submit with this Amendment and Response a definition for resin as defined in McGraw-Hill Dictionary of Scientific and Technical Terms, Sixth Ed., 2003, pg. 1792. Applicants also submit definitions for resin obtained from online dictionary websites. Examiner states that it is unclear what resin is intended. Applicants submit that the term resin is clear and what resin need not be specified in the claim just as what polyurethane need not be further specified.

Applicants submit that claim 34 is definite and requests the withdrawal of the 35 U.S.C. § 112¶2 rejection of claim 34.

### **Fees**

The Applicants believe no fee is due in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any required fee to our Deposit Account, 06-1448.

**Conclusion**

In view of the above amendments and remarks, the Applicants believe that the pending claims are in condition for allowance. If a telephone conversation with Applicant's Agent would expedite prosecution of the application, the Examiner is urged to contact the undersigned.

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